

REMARKS

This Amendment is submitted in response to the non-final Office Action mailed on January 11, 2008. No fee is due in connection with this Amendment. The Director is authorized to charge any fees which may be required, or to credit any overpayment to Deposit Account No. 02-1818. If such a withdrawal is made, please indicate the Attorney Docket No. 112701-568 on the account statement.

Claims 1-20 are pending in this application. Claim 9 was previously canceled without prejudice or disclaimer. In the Office Action, Claims 1-8 and 10-16 are rejected under 35 U.S.C. §102. Claims 17-20 are rejected under 35 U.S.C. §103. In response, Claim 1 has been amended. This amendment does not add new matter. In view of the amendment and/or for at least the reasons set forth below, Applicants respectfully submit that the rejections should be withdrawn.

In the Office Action, the Drawings are objected to. See, Office Action, page 2, lines 8-10. In response, Applicants have replaced Figures 1-9 to make the drawings more legible. Nothing in the Figures has been changed. Thus, Applicants respectfully submit that the objections regarding the Figures be reconsidered and withdrawn.

In the Office Action, Claims 1-8 and 10-16 are rejected under 35 U.S.C. §102(b) as being anticipated by GB 2027662 to Marek ("*Marek*"). In response, Claim 1 has been amended. Currently amended independent Claim 1 recites, in part, a beverage portioned package for preparing a beverage in an extraction device, wherein the package contains a water-soluble beverage material in an amount sufficient to form the beverage and a filler; with the filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material, wherein the ratio of water-soluble material to filler is between 1:1 and 1:8 by volume. The amendment does not add new matter. The amendment is supported in the Specification, for example, at page 9, lines 4-10. In view of the amendment and for the reasons set forth below, Applicants respectfully submit that *Marek* fails to disclose or suggest every element of the present claims.

For example, *Marek* fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the package contains a water-soluble beverage material as required, in part, by independent Claim 1. The water-soluble beverage

material provides the primary beverage ingredient for the beverage which is delivered through an extraction device. See, Specification, page 6, lines 30-33. The portion of water-soluble beverage material is intended to thoroughly mix with water during the extraction. See, Specification, page 7, lines 1-2. The water-soluble beverage material includes, for example, soluble coffee powder, milk powder, creamer powder, cocoa powder and mixtures thereof. See, Specification, page 7, lines 6-7. In contrast, *Marek* fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the package contains a water-soluble beverage material as required, in part, by the present claims.

Marek is entirely directed to a filter bag for coffee preparation that contains ground coffee or coffee mixtures in ground form. See, *Marek*, page 1, lines 22-25 and 45-54. *Marek* specifically states that “[t]he term coffee used herein means conventional roasted coffee or corresponding coffee mixtures in ground form.” See, *Marek*, page 1, lines 55-57. The Specification states that the filler may be any water-insoluble material and includes cellulose, fiber, fresh ground coffee or spent ground coffee. See, Specification, page 7, lines 19-20 and 28-29. Thus, the ground coffee and ground coffee mixtures of *Marek* are water-insoluble materials. Unlike the water-insoluble ground coffee disclosed in *Marek*, the present claims are directed to a water-soluble beverage material such as soluble coffee powder, milk powder, creamer powder, cocoa powder and mixtures thereof. See, Specification, page 7, lines 6-7. Therefore, *Marek* fails to disclose a beverage portioned package for preparing a beverage in an extraction device, wherein the package contains a water-soluble beverage material in accordance with the present claims.

The Examiner asserts that *Marek* teaches a water-soluble beverage material that either wholly or partially constitutes the beverage material. See, Office Action, page 5, lines 25-27. However, the passage of *Marek* relied on by the Examiner merely states that the term “coffee” as used in *Marek* also refers to coffee “which may be replaced wholly or partly b[y] coffee substitutes or contain coffee additives.” See, *Marek*, page 1, lines 57-62. Coffee substitutes include roasted barley grains and chicory and may be in finely powdered/soluble form, ground form or left whole. See, Wikipedia Online Encyclopedia, http://en.wikipedia.org/wiki/Coffee_substitute. If the coffee substitutes are all in ground form,

such substitutes are insoluble in water. Thus, contrary to the Examiner's assertion, the mere disclosure of coffee substitutes does not necessarily disclose water-soluble beverage materials.

Even if the coffee of *Marek* consists entirely of coffee substitutes, such substitutes are not water-soluble materials. *Marek* specifically states that the term "coffee" means "roasted coffee or coffee mixtures in ground form. However, this term also refers to coffee. . . which may be replaced wholly or partly by coffee substitutes." See, *Marek*, page 1, lines 55-62. Even if the "coffee" is replaced by coffee substitutes, the limitation of "in ground form" may be read to apply to such substitutes. Furthermore, the filter bags of *Marek* contain one or more neutral anti-agglomerating materials "which prevent the coffee from agglomerating during brewing." See, *Marek*, page 1, lines 45-50 and 68-70. Such anti-agglomerating materials reduce or prevent agglomeration of the coffee by keeping the grains physically separate or loose. See, *Marek*, page 1, lines 70-74. Since *Marek* does not limit or eliminate the use of anti-agglomerating materials when coffee substitutes are used, such coffee substitutes must also contain grains that have a tendency to agglomerate and are insoluble in water. As such, *Marek* fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the package contains a water-soluble beverage material as required, in part, by independent Claim 1.

Moreover, *Marek* fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the ratio of water-soluble material to filler is between 1:1 and 1:8 by volume as required, in part, by the present claims. "The volume herein refers to the non-compacted and non-tapped volume of bulky material measured in a standard volumetrically graduated cylinder." See, Specification, page 9, lines 5-7. In contrast, *Marek* fails to disclose or suggest a ratio of water-soluble material to filler between 1:1 and 1:8 by volume.

The only disclosure of the quantity of filler in *Marek* states that the amount of neutral anti-agglomerating materials "range[s] generally from approximately 0.1 to 100%, preferably from 1 to 50%, relative to the coffee." See, *Marek*, page 1, lines 91-95. Even if the coffee substitutes in *Marek* are considered water-soluble materials, *Marek* merely teaches a coffee to filler ratio between 1:0.001 and 1:1. Contrary to the Examiner's assertion, see, Office Action, page 5, lines 25-31, if the amount of filler is between 0.1% and 100% relative to the coffee, the ratio of coffee to filler ranges from 1:0.001 to 1:1, not 1:0.5 to 1:10. Moreover, *Marek* never

discloses whether the ratio of coffee to filler is a volume ratio. Therefore, *Marek* fails to disclose or suggest a beverage portioned package for preparing a beverage in an extraction device, wherein the ratio of water-soluble material to filler is between 1:1 and 1:8 by volume as required, in part, by independent Claim 1.

Accordingly, Applicants respectfully request that the rejection of Claims 1-8 and 10-16 under 35 U.S.C. §102(b) to *Marek* be withdrawn.

In the Office Action, Claims 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Marek* in view of U.S. Patent No. 6,777,007 B2 to Cai ("*Cai*"). For at least the reasons set forth below, Applicants respectfully submit that, even if combinable, the cited references fail to disclose or suggest every element of the present claims.

With respect to Claims 17-19, as discussed previously, *Marek* fails to disclose or suggest every element of independent Claim 1 from which Claims 17-19 depend. The Examiner relies on *Cai* only for the disclosure of a filter pod and brewing soluble substances under pressure; the Examiner relies on *Marek* for the specific ingredients of the beverage package. See, Office Action, page 5, lines 2-17; page 6, lines 15-17. Therefore, Applicants respectfully submit that *Cai* fails to remedy the deficiencies of *Marek* with respect to Claims 17-19.

With respect to Claim 20, the cited references fail to disclose or suggest a method of making a foamed beverage from a soluble beverage-forming material in a beverage portioned package that is processed in an extraction device, the method comprising providing the package with a water-soluble beverage material and a filler therein, the filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage above that which is created by the sole resistance of the package as required, in part, by the present claims. The filler maintains a sufficient pressure of extraction while the water-soluble beverage material dissolves in the water passing through the package to release the beverage. See, Specification, page 2, lines 25-28. The filler is configured to decrease the pressure drop during extraction to less than 0.2 bars. See, Specification, page 3, lines 3-6. Maintaining the pressure during extraction ensures that the beverage delivers the desired solids concentration and that a sufficient amount of foam is created. See, Specification, page 2, lines 29-31. A beverage package including such filler thus provides significantly improved properties over beverage packages that do not contain such a filler. See, Specification, page 2, lines 31-32.

In direct contrast, the filler disclosed in *Marek* is adapted to decrease the pressure in the coffee bags. For example, the purpose of the filler is to prevent or reduce agglomeration of the coffee by keeping the grains physically separate or loose. See, *Marek*, page 1, lines 70-78. However, breaking up the grains and keeping them loose acts to decrease the pressure, rather than maintain the pressure. Thus, *Marek* teaches the use of a filler to create a lower pressure than that of the beverage package or coffee alone. As such, *Marek* fails to disclose or suggest a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage above that which is created by the sole resistance of the package as required, in part, by the present claims.

Similarly, *Cai* fails to disclose or suggest a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage above that which is created by the sole resistance of the package. The Examiner relies on *Cai* merely for the disclosure of brewing soluble substances under pressure and using a “pod” arrangement to produce an infused beverage. See, Office Action, page 6, lines 15-17. Nowhere does *Cai* disclose a filler adapted to maintain extraction pressure above that which is created by the package alone, nor does the Examiner cite support for such limitation. Therefore, the cited references fail to disclose or suggest a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage above that which is created by the sole resistance of the package as required, in part, by independent Claim 20.


Accordingly, Applicants respectfully request that the rejection of Claims 17-20 under 35 U.S.C. §103(a) to *Marek* in view of *Cai* be withdrawn.

For the foregoing reasons, Applicants respectfully request reconsideration of the above-identified patent application and earnestly solicit an early allowance of same. In the event there remains any impediment to allowance of the claims that could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Respectfully submitted,

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